

RECEIVED
CENTRAL FAX CENTER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OCT 28 2004

In re application of: JOHN A. HAGAN

Serial No.: 09/618,500

Examiner: S. Castellano

Filed: July 18, 2000

Art Unit: 3727

For: CONTAINER

Attorney Docket No.: RPC 0515 PUS

PETITION TO WITHDRAW NOTICE OF NON-COMPLIANCECommissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant requests the withdrawal of the Notice of Non-Compliance mailed October 4, 2004.

Brief Summary of Relevant Facts

On December 9, 2003, Appellant filed a Notice of Appeal.

On April 12, 2004, Appellant filed an Appeal Brief.

On October 4, 2004, the Examiner mailed a Notice of Non-Compliance with the following objections:

Item 5: Issue 1 and Issue 2 state "unpatentable over" rather than "anticipated by."

Item 7: Issues 4 and 5 pertaining to claims 15 and 16 are not argued under a separate heading as the main argument is the same and appears under the heading for issue 2 for claim 14.

Note: The rules for filing a brief have changed as of September 13, 2004. file the brief in accordance with the new rules.


Stephen J. Castellano
Primary Examiner
Art Unit: 3727

CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being facsimile transmitted to Technology Center 3700, U.S. Patent & Trademark Office, at (703) 872-9306 on:

October 27, 2004
Date of Deposit

Stephanie M. Mansfield
Name of Person Signing


Signature

Serial No.: 09/618,500

Arty Docket No.: RPC 0515 PUS

Argument and Request for Relief

Introduction

None of these objections by the Examiner merit rejection of Appellant's Appeal Brief and further delay of review of the patentability of Appellant's patent application. Although the objections could be addressed in a Substitute Appeal Brief, Appellant requests intervention in this matter due to this Examiner's repeated unfair treatment of Appellant's patent applications (*see, for example*, Decisions on Petitions, Exhibit A).

Item 5

The Examiner objects to Appellant's use of the phrase "unpatentable over" as opposed to "anticipated by" in issues 1 and 2 which involve rejections under 35 U.S.C. § 102(b) (*see* Appeal Brief, p. 4, Exhibit B). Appellant asserts that issues 1 and 2 are perfectly clear as presented, since the statute is included in the statement of each issue. In fact, the examples cited in M.P.E.P. § 1206 each include the language of "[w]hether claims 1 and 2 *are unpatentable...*" (emphasis added) regardless of the particular statute under which the claims are rejected (*see* Exhibit C). In compliance with 37 C.F.R. § 1.192(c)(6), Appellant has properly provided a concise, accurate statement of the issues presented for review. The Examiner's objection to the specific wording of issues 1 and 2 is not an appropriate ground for deeming Appellant's Brief to be non-compliant.

Item 7

The Examiner states that issues 4 and 5 pertaining to claims 15 and 16, respectively, are not properly argued under a separate heading since the main argument is the same as that of claim 14 which appears under the heading for issue 2. Independent claim 14 stands rejected under 35 U.S.C. § 102(b) over Cloyd, whereas claims 15 and 16 depending therefrom are each separately rejected under 35 U.S.C. § 103(a) over a combination of Cloyd in view of one or more references. Pursuant to 37 C.F.R. § 1.192(c)(8), since claims 15 and 16 are rejected under different grounds than claim 14 and therefore properly presented as different issues, the arguments with respect to claims 15 and 16 are properly set out with separate headings (*see* Appeal Brief, pp. 15-16, Exhibit D). However, no additional arguments regarding either claim 15 or claim 16 are necessary beyond that presented for claim 14 under

Serial No.: 09/618,500

Atty Docket No.: RPC 0515 PUS

its heading, as Appellant has chosen to rely upon the argument for the patentability of claim 14 in asserting the patentability of claims 15 and 16 depending therefrom. The argument for claim 14 is clearly referenced under the headings for both claims 15 and 16, and thus provides the Board with a record that it can examine as efficiently as possible. The Examiner's insistence that the argument for claim 14 be reprinted three separate times actually makes the review process less efficient and is not a proper ground for rejection of Appellant's Brief.

New Rules

In the Notice of Non-Compliance, the Examiner instructs Appellant to "file the brief in accordance with the new rules." Even if Appellant were to file a Substitute Brief, this instruction by the Examiner is incorrect. With reference to the PTO Pre-OG Notice entitled "Clarification of the Effective Date Provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule), Appellant has the option of complying with either the new or old rules in the present situation (*see* Exhibit E). Specifically:

Question 6. If an appeal brief filed before the effective date of September 13, 2004 fails to comply with the content and format requirements of § 1.192 and the Office mails appellant a Notice that correction is required, would an amended appeal brief filed on or after the effective date be required to be in compliance with § 41.37(c)?

No, an amended appeal brief, based on an appeal brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former § 1.192 or § 41.37(c), regardless of when the Office mailed a Notice requiring correction of the noncompliant appeal brief.

No fee should be due in connection with this paper. However, if any fees are due, please charge our Deposit Account 02-3978.

Respectfully submitted,

JOHN A. HAGAN

By: Stephanie M. Mansfield
Stéphanie M. Mansfield; Reg. No. 43,773
Attorney/Agent for Applicant

Date: October 27, 2004

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: (248) 358-4400; Fax: (248) 358-3351